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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,511	07/29/2005	Pascal Agin	Q83285	4050
23373 7590 10/17/2007 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER BOKHARI, SYED M	
			ART UNIT 2616	PAPER NUMBER
			MAIL DATE 10/17/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	10/509,511		AGIN ET AL.	
	Examiner		Art Unit	
	Syed Bokhari		2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/28/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because of (a) the total number of words used exceeds the limit as described above and (b) the phrases "said method" line 1, "said parameters" line 1, "said transmission gap" line 2, "said method" line 3, and "said position" line 4. Corrections are required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-4 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Studle (2002/0006119 A1 in view of Virtanen (2001/0008521 A1).

Steudle discloses a communication system for defining measurement gaps in inter-frequency measurement with the following features: regarding claim 1, compressed mode configuration method in a mobile radio system (Fig. 1, UMTS mobile structure, see "compressed mode" recited in paragraph 0014 lines 1-4), in which method a compressed mode configuration is defined by compressed mode parameters

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(Fig. 3, generation of measurement gap, see "compressed mode parameters" recited in paragraph 0043 lines 1-18), the compressed mode parameters including a transmission gap length TGL (Fig. 3, generation of measurement gap, see "transmission gap length (TGL)" recited in paragraph 0043 lines 6-8), a transmission gap pattern length TGPL (Fig. 3, generation of measurement gap, see "transmission gap pattern length (TGPL)" recited in paragraph 0043 lines 9-12) in which method a compressed mode configuration is chosen from a set of reference compressed mode configurations (Fig. 2, frame structure, see "set of compressed mode" recited in paragraph 0041 lines 1-9), the compressed mode parameters are determined so that, for each reference configuration (Fig. 3, generation of measurement gap, see "parameters signaled to mobile station" recited in paragraph 0042 lines 13-16), then TGL is made sufficiently large so that two transmission gaps to occur at two of the positions (Fig. 3, generation of measurement gap, see "larger gap" recited in paragraph 0042 lines 5-13); regarding claim 2, or otherwise a transmission gap pattern comprises a plurality of transmission gaps (Fig. 3, generation of measurement gap, see "transmission gap pattern length (TGPL)" recited in paragraph 0043 lines 9-12);

regarding claim 3, in which the first system is of the UMTS type (Fig. 1, mobile telephone system, see "Universal mobile telephony system (UMTS)" recited in paragraph 0045 lines 1-6) and the second system is of the GSM type (Fig. 2, frame structure, see "measurements between WCDMA and GSM" recited in paragraph 0041 lines 1-9), and TGL is chosen from the group comprising the values 11, 12, 13, 14 (Fig. 3, generation of measurement gap, see "TGL group" recited in paragraph 0041 lines 1-

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9); regarding claim 9, in which the first system is of the UMTS type (Fig. 1, mobile telephone system, see "Universal mobile telephony system (UMTS)" recited in paragraph 0045 lines 1-6), the second system is of the GSM type (Fig. 2, frame structure, see "measurements between WCDMA and GSM" recited in paragraph 0041 lines 1-9) and a transmission gap pattern comprises two transmission gaps (Fig. 3, generation of measurement gap, see "two transmission gaps" recited in paragraph 0042 lines 1-5); regarding claim 10, network equipment for mobile radio system comprising (Fig. 1, mobile telephone system, see "UMTS and GSM" recited in paragraph 0045 lines 1-6) and means for implementing a compressed mode configuration method (Fig. 3, generation of measurement gap, see "means for implementation" recited in paragraph 0050 lines 1-8); regarding claim 11, terminal for mobile radio system comprising (Fig. 1, mobile telephone system, see "UMTS and GSM" recited in paragraph 0045 lines 1-6) and means for implementing a compressed mode configuration method (Fig. 3, generation of measurement gap, see "means for implementation" recited in paragraph 0050 lines 1-8).

Steudle does not disclose the following features: regarding claim 1, the transmission gaps being defined in a first transmission time structure specific to a first system, being determined relative to a second transmission time structure specific to a second system, to enable measurements on the second system to be effected in the first system, if the TGPL is such that the transmission gaps occur periodically at fixed positions in the second structure, and the closest together, overlap, with an overlap length greater than the time necessary to effect a measurement; regarding claim 2, in

which the compressed mode parameters are determined so that, otherwise and for each reference configuration, TGPL is chosen so that the transmission gaps do not occur periodically at fixed positions in the second structure; regarding claim 4, in which TGL preferably has the value 14.

Virtanen discloses communication system with a method of preparing a inter-frequency handover with the following features: regarding claim 1, the transmission gaps being defined in a first transmission time structure specific to a first system (Fig. 3, transmission period, see "first frequency transmission gaps" recited in paragraph 0024 lines 1-7), being determined relative to a second transmission time structure specific to a second system (Fig. 4, transmission gap pattern, see "second transmission gap" recited in paragraph 0024 lines 7-9), to enable measurements on the second system to be effected in the first system (Fig. 3, transmission period, see "performing measurements" recited in paragraph 0025 lines 1-3), if the TGPL is such that the transmission gaps occur periodically at fixed positions in the second structure (Fig. 2, position of transmission gap, see "similar transmission gap period" recited in paragraph 0009 lines 1-11) and the closest together, overlap, with an overlap length greater than the time necessary to effect a measurement (Fig. 4, transmission period, see "transmission gap overlapping" recited in paragraph 0055 lines 1-12); in which the compressed mode parameters are determined so that, otherwise (Fig. 6, data transmitted in compressed mode, see "step 604" recited in paragraph 0062 lines 1-11 and paragraph 0063 lines 8-9) and for each reference configuration, TGPL is chosen so that the transmission gaps do not occur periodically at fixed positions in the second

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structure (Fig. 4, transmission gap pattern (TGP) and fig. 6, step 605, see "duration of transmission gap period (TGP)" recited in paragraph 0056 lines 1-9 and paragraph 0063 lines 9-13) and regarding claim 4, in which TGL preferably has the value 14 (Fig. 2, position of transmission gaps, see "gap of 14 time slots" recited in paragraph 0014 lines 8-11 and table 1 of prior art).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the method of Studle by using the features, as taught by Virtanen in order to provide the function of first transmission time structure and second time structure. The motivation of doing this is to enhance the functionality of transmission/receipt in a cost effective manner.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Studle (2002/0006119 A1 in view of Virtanen (2001/0008521 A1) as applied to claim 1 above, and further in view of Vayanos et al. (2003/0026235 A1).

Studle and Virtanen describe the claimed limitations as discussed in paragraph 6 above. Studle and Virtanen do not disclose the following features: regarding claim 5, in which the first system is of the UMTS type, the second system is of the GSM type, and TGPL is chosen so that it is not a multiple of 6.

Vayanos et al. discloses the techniques to time-share a common channelization code among multiple terminals for compressed mode transmission with the following features: regarding claim 5, in which the first system is of the UMTS type (Fig. 5, frame

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format and slot format, see "UMTS radio access network (UTRAN)" recited in paragraph 0044 lines 1-9), the second system is of the GSM type (Fig. 1, wireless communication system, see "GSM system" recited in paragraph 0064 lines 1-3) and TGPL is chosen so that it is not a multiple of 6 (Fig. 6, compressed mode transmission, see "transmission gap pattern length (TGPL)" recited in paragraph 0064 lines 3-10). It would have been obvious to one of ordinary skill in the art at the time of invention to modify the method of Studle with Virtanen by using the features, as taught by Vayanos et al., in order to provide the function of multiple TGPL. The motivation of doing so is to enhance the function to the level of W-CDMA in cost effective manner.

8. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Studle (2002/0006119 A1 in view of Virtanen (2001/0008521 A1) ^{& Vayanos et al} as applied to claim 1 above, and further in view of the Change of Request report (Utilization of compressed mode for BSIC reconfirmation, document R2-002434, spec. 25.922, CR 011 and version 3.3.0). D. 20

Studle and Virtanen describe the claimed limitations as discussed in paragraph 6 above. Studle and Virtanen do not disclose the following features: regarding claim 6, in which TGPL is chosen from a group comprising the values 13, 14, 15, 16; regarding claim 7, in which for TGPL equal to 13, TGL is chosen from a group comprising the values 5, 7, 10, 14 and regarding claim 8, in which for TGPL equal to 16, TGL is chosen from a group comprising the values 7, 10, 14.

The above CR document discusses the utilization of compressed mode for BSIC

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Reconfirmation with the following features: regarding claim 6, in which TGPL is chosen from a group comprising the values 13, 14, 15, 16 (table, transmission gap pattern sequences, see "TGPL with TGL for BSIC reconfirmation" recited in paragraph 6 on page 3GPP); regarding claim 7, in which for TGPL equal to 13, TGL is chosen from a group comprising the values 5, 7, 10, 14 (table, transmission gap pattern sequences, see "TGPL with TGL for BSIC reconfirmation" recited in paragraph 6 in 5.1.6.2.3.3) and regarding claim 8, in which for TGPL equal to 16, TGL is chosen from a group comprising the values 7, 10, 14 (table, transmission gap pattern sequences, see "TGPL with TGL for BSIC reconfirmation" recited in paragraph 6 page 3GPP).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the method of Studle with Virtanen by using the features, as indicated in the above CR, in order to provide the function of multiple TGPL comprising value of 13,14,15,16 and selection of TGL or TGPL with respect to other selected value of either. The motivation of doing so is to enhance the function with the setting of the parameters as outlined in GSM BSIC reconfirmation.

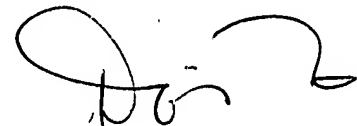
Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USP 6,868,075 B1 (Narvinger et al.), US 2002/0003785 A1 (Agin), US 2003/0092382 (Vayanos et al.) and USP 5,533,014 (Willars et al.).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Bokhari whose telephone number is (571) 270-3115. The examiner can normally be reached on Monday through Friday 8:00-17:00 Hrs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kwang B. Yao can be reached on (571) 272-3182. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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